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|                                     |   |                       |
|-------------------------------------|---|-----------------------|
| In re Application of                | : |                       |
| Barta, et al.                       | : |                       |
| Serial No.: 10/088,989              | : | DECISION ON           |
| PCT No.: PCT/HU00/00099             | : | RENEWED PETITION      |
| Int. Filing Date: 23 September 2000 | : | UNDER 37 CFR 1.137(b) |
| Priority Date: 23 September 1999    | : |                       |
| Attorney's Docket No.: IDR0242-USA  | : |                       |
| For: PROCESS FOR THE PREPARATION OF | : |                       |
| MYCOPHENOLIC ACID AND               | : |                       |
| DERIVATIVES THEREOF                 | : |                       |

This decision is responsive to the "RENEWED PETITION UNDER 37 C.F.R. 1.137(b)" filed 08 September 2005.

**BACKGROUND**

On 22 September 2000, applicants filed international application PCT/HU00/00099, which claimed priority of an earlier Hungarian application filed 23 September 1999. On 22 March 2001, a Demand (form PCT/IPEA/401) for International Preliminary Examination was filed. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 23 March 2002.

On 23 March 2002, applicants filed a transmittal letter for entry into the national stage in the United States. The transmittal letter was accompanied by, *inter alia*, a copy of the international application and authorization to charge the basic national fee. These papers were assigned Application No. 10/088,989.

On 22 July 2002, the United States Patent and Trademark mailed the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicant was required to file an oath/declaration and additional claim fees. The notification set a two-month time period in which to respond.

On 19 November 2002, applicant filed the executed declarations along with authorization to charge the deposit account for the extra claim fees.

On 17 January 2003, the United States Patent and Trademark mailed the "NOTIFICATION OF DEFECTIVE RESPONSE" (form PCT/DO/EO/916) indicating that the declaration was not executed by inventor Antonia Jekkel. The notification set a one-month time period in which to respond.

On 12 December 2003, the United States Patent and Trademark mailed the "NOTIFICATION OF ABANDONMENT" (form PCT/DO/EO/909) indicating that the application had become abandoned for failure to respond to the form PCT/DO/EO/916.

On 13 December 2004, applicant a petition to revive along with a declaration executed by all of the inventors.

On 16 June 2005, a decision was mailed to applicant indicating that applicant was required to provide a new declaration which included the citizenship, residence and mailing address of the legal representative and the deceased inventor.

On 08 September 2005, applicant filed the current response which included a new declaration and a one month extension of time, along with the proper extension of time fee.

### **DISCUSSION**

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional delay must be filed promptly after the applicant becomes aware of the abandonment and such petition must be accompanied (1) by a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," (2) by a proper reply, (3) by the petition fee required by law (37 CFR 1.17(m)), and (4) if the international filing date of the application is before June 8, 1995, any petition to revive under 37 CFR 1.137(b) must be accompanied by a terminal disclaimer and small entity fee of \$55

Applicants provided the required statement and the petition fee in the earlier filed petition.

With respect to applicants' declarations in the current application, 37 CFR 1.42 states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

37 CFR 1.497 states, in part:

- (a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to 1.494 or 1.495, he or she must file an oath or declaration that:
- (1) Is executed in accordance with either 1.66 or 1.68;
  - (2) Identifies the specification to which it is directed;
  - (3) Identifies each inventor and the country of citizenship of each inventor; and
  - (4) States that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.
- (b) (1) The oath or declaration must be made by all of the actual inventors except as provided for in 1.42, 1.43 or 1.47.
- (2) If the person making the oath or declaration is not the inventor, the oath or declaration shall state the relationship of the person to the inventor, the facts required by 1.42, 1.43 or 1.47, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.


Applicant has provided the address and citizenship for the deceased inventor (Antonia Jekkel) and the legal representative (Eva Jekkel) of the deceased inventor.

### CONCLUSION

The petition to revive the application abandoned under 35 U.S.C. 371(d) is **GRANTED** as to the National Stage in the United States of America.

The declaration is accepted under 37 CFR 1.42.

This application is being forwarded to the national stage office for preparation of a "NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903) showing a 35 U.S.C. 371 date of **08 September 2005**.

  
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